

## REMARKS

Applicant submits this Response in reply to the Non-Final Office Action mailed on August 24, 2006. Claims 1, 10, 12 to 14, 16, 18 to 20, 22, 24 to 26, 28, 30 to 32, 34, 36 to 38, 40, 42 to 44, 46, 48 and 49 have been amended. No new matter was added by these amendments.

A Petition for One Month Extension of Time and a Supplemental Information Disclosure Statement are submitted herewith. Please charge deposit account number 02-1818 for the Petition for One Month Extension of Time, any fee due in connection with the Supplemental Information Disclosure Statement and any other fees associated with this Response.

The Office Action rejected Claims 38 to 43 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Office Action stated that it is not clear what causes the repeat of step (a) and that it is not clear what “the current repeat of steps means.” Applicant has made certain clarifying amendments to independent Claim 38 to place Claim 38 and the claims depending therefrom in condition for allowance.

The Office Action rejected Claims 1, 14, 20, 26 and 38 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Office Action stated that there is no antecedent basis for the limitation “the previously selected division.” Applicant has made clarifying amendments to independent Claims 1, 14, 20, 26 and 38. Accordingly, Applicant submits that such rejections have been overcome.

The Office Action rejected Claims 1 to 3, 7 to 9, 12, 14 to 15, 18, 20 to 21, 24, 26 to 27, 30, 32 to 33, 36, 38, 44 to 45 and 48 under 35 U.S.C. § 102(a) as being anticipated by Randall (WO 03/009240). Applicant respectfully disagrees with these rejections. Nonetheless, to expedite prosecution, Applicant has made clarifying amendments to certain claims to place the claims in condition for allowance.

Randall discloses a gaming device including a primary game and a secondary game. The secondary game includes a “wraparound trail” having different sections. (See page 10, lines 17 to 19). A winning outcome in the primary game allows the player to play the secondary game. During play of the secondary game, certain sections of the “trail” illuminate. If certain sections are illuminated, the player gets to select an award

from a "feature zone" 29 (see Fig. 3a; page 12, lines 9 to 12). The feature zone includes three columns. Each column is divided into a plurality of regions. Each region is associated with a color and each color is associated with an award. By pressing one of the buttons 25 to 27 (see Figs. 3a and 3b), the player selects which column to obtain an award from. The award the player receives from the selected column equals the total value of the awards associated with one or more like-colored regions located at the bottom of the selected column. (See Randall, Figs. 3a to 3b and their related descriptions). For example, referring to Fig. 3a, if the player selects button 25, the player receives an award equal to the sum of the values of three yellow regions. In Fig. 3a, if the bottom region in the column associated with button 25 was yellow and the region above it was green, the player would receive an award equal to the value of one yellow region.

In one embodiment, after the player selects an award, the colors in all regions of the "feature zone" shift downward by a number of regions equal to the number of regions comprising the award the player selected, such that the selected award is "shifted" out of the bottom of the feature zone, along with the colors in regions horizontally-aligned with the selected award. The colors in the regions above the newly down-shifted colored regions, then change (contrast Fig. 3a with Fig. 3b). As illustrated in Fig. 3b, in this embodiment, colors are not removed from the "feature zone" permanently, their positions merely change.

The method of operating a gaming device of amended independent Claim 1 includes, amongst other elements, decreasing an amount of symbols in the set by eliminating the symbols not associated with the selected division if there is more than one symbol in the selected division and providing an award to the player based on the symbol of the selected division if the symbol is the only symbol in the selected division.

Similarly, the method of operating a gaming device of amended independent Claim 14 includes, amongst other elements, decreasing the amount of different symbols if the selected division includes more than one symbol and providing an outcome to the player based on the symbol of the selected division if the symbol is the only symbol in the selected division.

Randall does not disclose decreasing an amount of symbols in a set by eliminating the symbols not associated with a selected division if there is more than one symbol in the selected division. In Randall, the number of colors utilized in the game does not decrease when the player selects an award. As described above, when the colors shift downward after the player selects an award, the gaming device replenishes the regions at the top of the "feature zone" with new colors, from the same set of colors already being utilized. The number of different colors is not diminished as a result of a player selecting a column.

Further, Randall does not disclose providing an award to a player based on a symbol of the selected division if the symbol is the only symbol in the selected division. Rather, in Randall the player receives an award associated with one or more regions which are the same color and are grouped together at the bottom of the selected column (see Randall, Figs. 3a to 3b and their related descriptions). In Randall, the player is provided with an award for one or more like-colored regions in a column. Accordingly, Applicant respectfully submits that independent Claims 1 and 14 are patentably distinguished over Randall and in condition for allowance.

Claims 2, 3, 7 to 9, and 12, which depend directly from amended independent Claim 1, and Claims 15 and 18, which depend directly from amended independent Claim 14, are also allowable for the reasons given with respect to Claims 1 and 14 and because of the additional features recited in those claims.

The method of operating a gaming device of amended independent Claim 20 includes: (a) displaying a plurality of different symbols to the player; (b) sorting said symbols into a plurality of divisions of symbols without revealing to the player which symbols are sorted into which divisions; (c) enabling the player to select one of the divisions of symbols; (d) decreasing the amount of different symbols if the amount of different symbols in the selected division is greater than the current number of divisions; (e) displaying the remaining different symbols to the player if the amount of the remaining different symbols in the selected division is greater than the current number of divisions; (f) repeating (b) to (e) at least once, wherein the amount of different symbols displayed equals the amount of symbols in the selected division; and (g)

providing an outcome to the player based on any symbols in the selected division after repeating (b) to (e) at least once.

In Randall, the gaming device displays all of the regions in the “feature zone” and the colors associated therewith. In the method of operating a gaming device of Claim 20, symbols are sorted into a plurality of divisions without revealing to a player what symbols are sorted into which divisions. In Randall, the player is shown what award options (via the colors of the regions) are available to them in the three columns of the “feature zone” prior to selecting a column, such that the player may determine what award they want.

Further, in Randall, the player does not have to repeat the column selection process to receive an award. Whereas, the method of operating a gaming device of independent Claim 20 includes providing an outcome to a player based on any symbols in the selected division after repeating (b) to (e) at least once. That is, the method of operating a gaming device of amended independent Claim 20 includes an iterative award-selection process, while Randall discloses a one-step award selection process. Accordingly, Applicant respectfully submits that Claim 20 is patentably distinguished over Randall and in condition for allowance.

Claims 21 and 24, which depend directly from amended independent Claim 20, are also allowable for the reasons given with respect to Claim 20 and because of the additional features recited in these claims.

The method operating a gaming device of amended independent Claim 26 includes the steps of: (a) displaying a plurality of different symbols to the player; (b) sorting said symbols into a plurality of divisions of symbols without revealing to the player which symbols are sorted into which divisions; (c) enabling the player to select one of the divisions of symbols; (d) decreasing the amount of different symbols based on the symbols sorted into the selected division if the selected division has a number of symbols greater than a designated number of symbols, said designated number being greater than one; (e) displaying the remaining different symbols to the player if the selected division has a number of symbols greater than said designated number of symbols; (f) repeating (b) to (f) until the selected division has said designated number of

symbols; and (g) providing an outcome to the player based on any of the symbols of the selected division if the selected division has said designated number of symbols.

In Randall, a column need not include a designated number of colored regions for a player to receive an award. Thus, Randall does not disclose providing an outcome to the player based on any of the symbols of the selected division if the selected division has the designated number of symbols. Accordingly, Applicant respectfully submits that Claim 26 is patentably distinguished over Randall and in condition for allowance.

Claims 27 and 30, which depend directly from amended independent Claim 26, are also allowable for the reasons given with respect to Claim 26 and because of the additional features recited in these claims.

The method of amended Claim 32 includes the steps of: (a) displaying a plurality of different symbols to the player; (b) sorting said symbols into a plurality of divisions of symbols without revealing to the player which symbols are sorted into which divisions; (c) enabling the player to select one of the divisions of symbols; (d) decreasing the amount of different symbols if the number of symbols in the selected division is greater than the current number of divisions of symbols; (e) displaying the remaining different symbols; (f) repeating (b) to (f) until an amount of different symbols previously displayed in (e) is the same as the current number of divisions of symbols; and (g) providing an outcome to the player based on any of the symbols of the selected division when the amount of different symbols previously displayed in (e) is the same as the current number of divisions of symbols.

Randall does not disclose as a prerequisite to a player receiving an award, that the number of colors in a previously displayed column equal the current total number of columns. Whereas the method of operating a gaming device of Claim 32 includes providing an outcome to the player based on any of the symbols of the selected division when the amount of different symbols previously displayed in (e) is the same as the current number of divisions of symbols. Accordingly, Applicant respectfully submits that Claim 32 is patentably distinguished over Randall and in condition for allowance.

Claims 33 and 36, which depend directly from amended independent Claim 32, are also allowable for the reasons given with respect to Claim 32 and because of the additional features recited in these claims.

Similarly, the method of operating a gaming device of amended independent Claim 38 includes, amongst other elements, providing an outcome to the player based on any of the symbols of the selected division when the amount of symbols in the previously selected division equals the current number of divisions. Randall does not disclose as a prerequisite to a player receiving an award, that the number of colors in a previously selected column equal the current total number of columns. Accordingly, Applicant respectfully submits that Claim 38 is patentably distinguished over Randall and in condition for allowance.

The method of operating a gaming device of amended independent Claim 44 includes, amongst other elements, providing an outcome to the player based on the symbol of the selected division if the symbol is the only symbol in the selected division. Randall does not disclose providing an award to a player if a symbol is the only symbol in a selected division. Rather, in Randall the player receives an award associated with one or more like-colored regions which are grouped together at the bottom the selected column (see Randall, Figs. 3a to 3b and their related descriptions). Accordingly, Applicant respectfully submits that Claim 44 is patentably distinguished over Randall and in condition for allowance.

Claims 45 and 48, which depend directly from amended independent Claim 44, are also allowable for the reasons given with respect to Claim 44 and because of the additional features recited in these claims.

The Office Action rejected dependent Claims 4, 13, 19, 25, 31, 37 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Randall. Applicant respectfully disagrees with these rejections.

In regards to Claim 4, the Office Action states that while "Randall lacks disclosing that the sorting of the symbols includes not placing the same symbol twice in any of the divisions, . . . it would be obvious to sort the division so that a division does not hold the same symbol twice." Applicant respectfully submits that regardless of whether or not it

would have been obvious to sort the division so that a division does not hold the same symbol twice, as described above, Randall does not teach, disclose or suggest a method of operating a gaming device which includes providing an award to a player based on a symbol of the selected division if the symbol is the only symbol in the selected division. On the other hand, the method of operating a gaming device of Claim 4 includes providing an award to a player based on a symbol of the selected division if the symbol is the only symbol in the selected division. For these reasons, Applicant respectfully submits that dependent Claims 4 is patentably distinguished over Randall and in condition for allowance.

In regards to Claims 13, 19, 25, 31, 37 and 49, the Office Action states that it would be obvious to use numerical symbols such as numbers to represent awards. Applicant respectfully submits that regardless of whether or not it would have been obvious to use numerical symbols such as numbers to represent awards, Randall does not teach, disclose or suggest a method of operating a gaming device which includes providing an award to a player based on a symbol of the selected division if the symbol is the only symbol in the selected division; displaying a plurality of different symbols to the player; sorting symbols into a plurality of divisions of symbols without revealing to the player which symbols are sorted into which divisions; providing an outcome to a player based on any symbols in the selected division after repeating (b) to (e) at least once (Claim 20); providing an outcome to the player based on any of the symbols of the selected division if the selected division has the designated number of symbols; or providing an outcome to the player based on any of the symbols of the selected division when the amount of different symbols previously displayed in (e) is the same as the current number of divisions of symbols (Claim 32). On the other hand, the methods of operating a gaming device of amended Claims 13 and 49 include providing an award to a player based on a symbol of the selected division if the symbol is the only symbol in the selected division. Moreover, unlike Randall, the method of operating a gaming device of Claim 19 includes displaying a plurality of different symbols to the player. Additionally, the method of operating a gaming device of Claim 25 includes providing an outcome to a player based on any symbols in the selected division after repeating (b) to

(e) at least once. Moreover, the method of operating a gaming device of Claim 31 includes providing an outcome to the player based on any of the symbols of the selected division if the selected division has the designated number of symbols. Further, unlike Randall, the method of operating a gaming device of Claim 37 includes providing an outcome to the player based on any of the symbols of the selected division when the amount of different symbols previously displayed in (e) is the same as the current number of divisions of symbols.

For these reasons, Applicant respectfully submits that dependent Claims 13, 19, 25, 31, 37 and 49 are patentably distinguished over Randall and in condition for allowance.

The Office Action rejected dependent Claims 10, 11, 16, 17, 22, 23, 28, 29, 35, 36, 46 and 47 under 35 U.S.C. § 103(a) as being unpatentable over Randall in view of Soltesz (U.S. 5,830,069). Applicant respectfully disagrees with these rejections.

Soltesz discloses the operation of gaming devices through a data network. The Office Action states that “it would be obvious to one of ordinary skill in the art to be motivated to modify Randall in view of Soltesz to provide a superior means to conduct multi-site integrated gaming activities and to transmit coverage in real time with pictures and audio of gaming activities, with reduced hardware cost per site, and reduces [sic] operating cost per game.” Applicant respectfully submits that regardless of whether or not it would have been obvious to one of ordinary skill in the art to modify Randall to incorporate a data network, as described above, the combination of Randall and Soltesz does not teach, disclose or suggest a method of operating a gaming device which includes providing an award to a player based on a symbol of the selected division if the symbol is the only symbol in the selected division; sorting symbols into a plurality of divisions of symbols without revealing to the player which symbols are sorted into which divisions; providing an outcome to a player based on any symbols in the selected division after repeating (b) to (e) at least once (Claim 20); providing an outcome to the player based on any of the symbols of the selected division if the selected division has the designated number of symbols; or providing an outcome to the player based on any



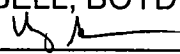
of the symbols of the selected division when the amount of different symbols previously displayed in (e) is the same as the current number of divisions of symbols (Claim 32).

On the other hand, unlike Randall, the methods of operating a gaming device of Claims 10, 11, 46 and 47 include providing an award to a player based on a symbol of the selected division if the symbol is the only symbol in the selected division. Further, the methods of operating a gaming device of Claims 16 and 17 include providing an outcome to a player based on a symbol of the selected division if the symbol is the only symbol in the selected division. Additionally, unlike Randall, the methods of operating a gaming device of Claims 22 and 23 include providing an outcome to a player based on any symbols in the selected division after repeating (b) to (e) at least once. Moreover, the methods of operating a gaming device of Claims 28 and 29 include providing an outcome to the player based on any of the symbols of the selected division if the selected division has the designated number of symbols. Further, unlike Randall, the methods of operating a gaming device of Claims 35 and 36 include providing an outcome to the player based on any of the symbols of the selected division when the amount of different symbols previously displayed in (e) is the same as the current number of divisions of symbols.

For these reasons, Applicant respectfully submits that dependent Claims 10, 11, 16, 17, 22, 23, 28, 29, 35, 36, 46 and 47 are patentably distinguished over the combination of Randall and Soltesz and in condition for allowance.

The Office Action indicated that Claims 5 and 6 contain allowable subject matter and may be allowable if rewritten in independent form. Applicant respectfully submits that dependent Claims 5 and 6 stand in condition for allowance without amendment.

Applicant has made an earnest endeavor to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,  
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